

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400



PATENT APPLICATION

ATTORNEY DOCKET NO. 10010208-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Mimi C. DONG

Confirmation No.: 9404

Application No.: 09/863,560

Examiner: Le, Brian Q.

Filing Date: May 23, 2001

Group Art Unit: 2621

Title: FINGERPRINT ADDRESSING SYSTEM AND METHOD

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 12, 2006.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) \$500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$120

☐ 2nd Month
\$450

☐ 3rd Month
\$1020

☐ 4th Month
\$1590

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 500. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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Typed Name: Cindy C. Dioso

Signature: Cindy C. Dioso

Respectfully submitted,

Mimi C. DONG

By: James L. Baudino

James L. Baudino

Attorney/Agent for Applicant(s)

Reg No. : 43,486

Date : March 13, 2006

Telephone : 214-855-7544



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Mimi C. Dong Confirmation No.: 9404
Serial No.: 09/863,560
Filing Date: May 23, 2001
Group Art Unit: 2621
Examiner: Le, Brian Q.
Title: FINGERPRINT ADDRESSING SYSTEM AND
METHOD
Docket No.: 10010208-1

MAIL STOP: APPEAL BRIEF PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Applicant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed October 20, 2005, finally rejecting Claims 1-19. Applicant filed a Notice of Appeal on January 12, 2006. Applicant respectfully submits herewith this Appeal Brief with authorization to charge the statutory fee of \$500.00.

REAL PARTY IN INTEREST

The present application was assigned to Hewlett-Packard Company as indicated by an assignment from the inventor recorded on September 24, 2001 in the Assignment Records of the United States Patent and Trademark Office at Reel 012197, Frame 0098. The present application was subsequently assigned to Hewlett-Packard Development Company, L.P. as indicated by an assignment from Hewlett-Packard Company recorded on September 30, 2003 in the Assignment Records of the United States Patent and Trademark Office at Reel 014061, Frame 0492. The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

RELATED APPEALS AND INTERFERENCES

There are no known appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in this pending appeal.

STATUS OF CLAIMS

Claims 1-19 stand rejected pursuant to an Office Action mailed October 20, 2005. Claims 1-19 are presented for appeal.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the mailing of the above-referenced Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

Embodiments of the present invention as defined by independent Claim 1 are directed toward a device (24, 50, 80) comprising connection to a network (22, 45, 74) and

a network address derived from a user's fingerprint (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

Embodiments of the present invention as defined by independent Claim 6 are directed toward a system (10) comprising a connection to a network (22, 45, 74) and a network address derived from a fingerprint of a user (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

Embodiments of the present invention as defined by independent Claim 14 are directed toward a method comprising generating a network address derived from a user's fingerprint and accessing a system over a network using the derived network address (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 2, 4-9 and 11-19 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,539,077 issued to Ranalli et al. (hereinafter "*Ranalli*").
2. Claims 1, 3, 6, 10 and 14 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,636,620 issued to Hoshino (hereinafter "*Hoshino*").
3. Claims 3 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ranalli*.

ARGUMENT

A. Standard

1. 35 U.S.C. § 102

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987); M.P.E.P. § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v.*

Suzuki Motor Co., 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); M.P.E.P. § 2131.

2. 35 U.S.C. § 103

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met: First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *Id.* Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Additionally, not only must there be a suggestion to combine the functional or operational aspects of the combined references, but also the prior art is required to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 F.2d 1173, 1183 (Fed. Cir. 1991). Moreover, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000).

B. Argument

1. First Ground of Rejection (Claims 1, 2, 4-9 and 11-19)

Claims 1, 2, 4-9 and 11-19 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,539,077 issued to *Ranalli*. Of the rejected claims, Claims 1, 6 and 14 are independent. Applicant respectfully submits that each independent claim

is patentable over the cited reference, and thus remaining Claims 2, 4, 5, 7-9, 11-13 and 15-19 which depend respectively therefrom are also patentable.

Embodiments of the present invention generally involve a fingerprint-based network addressing system (10) having a device (e.g., a mobile controller 24 and/or mobile device 50, 80) adapted to generate a network, or an Internet Protocol (IP), address (at least at page 3, lines 1-31, page 4, lines 3-16 and 17-31, page 5, lines 3-21, figures 1-3). For example, according to one embodiment of Applicant's invention, to access a server 16 and/or one of network-based appliances 18-21, a user scans his/her fingerprint using a fingerprint scanner 26 coupled to the mobile controller 24 (at least at page 4, lines 3-6). The mobile controller 24 analyzes the fingerprint data to generate an IP address (at least at page 4, lines 6-16). Accordingly, for example, independent Claim 1 recites a device comprising "a connection to a network" and a "network address derived from a user's fingerprint."

In the Office Action, the Examiner states that *Ranalli* discloses the limitations of independent Claim 1 because "*Ranalli* discloses a unique identifier which can be a fingerprint" (Office Action, page 3) (emphasis added). Applicant respectfully disagrees. Applicant respectfully points out that to support a rejection under 35 U.S.C. § 102, each and every element as set forth in a claim must be found in a single prior art reference. *Ranalli* does not disclose or even suggest, nor has the Examiner explicitly identified any disclosure in the *Ranalli* reference, that the "unique identifier" referred to by the Examiner in *Ranalli* is, in fact, a user's fingerprint. To the contrary, the Examiner's basis for supporting the § 102 rejection appears to be nothing more than the Examiner's own interjected idea of what the "unique identifier" of *Ranalli* could be. Clearly, the Examiner is looking beyond the *Ranalli* reference to maintain the § 102 rejection, which is improper. Accordingly, for at least this reason, Claim 1 is patentable over the *Ranalli* reference.

Further, *Ranalli* recites:

The present invention is directed to a method and apparatus designed to simplify communication between end users (source and destination) on a data network. More specifically, the invention provides a database on a data network to relate a unique identifier attached to a user, to a data network address by which the user may be reached. Presumably, the unique identifier is one readily available to those desiring to communicate with the user. For example, it may take the form of a telephone number by which the user is commonly reached.

(*Ranalli*, column 2, lines 22-33) (emphasis added). Applicant respectfully submits that a user's fingerprint is not "readily available to those desiring to communicate with the user" as indicated by *Ranalli*. Therefore, the Examiner's assertion that the "unique identifier" in *Ranalli* could be a fingerprint is clearly unsupported. Accordingly, for at least this reason also, Claim 1 is patentable over the *Ranalli* reference.

Independent 6 recites "a network address derived from a fingerprint of a user," and independent Claim 14 recites "generating a network address derived from a user's fingerprint." At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that independent Claims 6 and 14 are also patentable over the *Ranalli* reference.

Accordingly, for at least the reasons discussed above, independent Claims 1, 6 and 14, and Claims 2, 4, 5, 7-9, 11-13 and 15-19 that depend respectively therefrom, are in condition for allowance.

2. Second Ground of Rejection (Claims 1, 3, 6, 10 and 14)

Claims 1, 3, 6, 10 and 14 are rejected under 35 U.S.C. §102(e) as being anticipated by *Hoshino*. Of the rejected claims, Claims 1, 6 and 14 are independent. Applicant respectfully submits that each independent claim is patentable over the cited

reference, and thus remaining Claims 2, 4, 5, 7-9, 11-13 and 15-19 which depend respectively therefrom are also patentable.

In the Office Action, the Examiner states that *Hoshino* discloses a “network address derived from a user’s fingerprint (the accessibility to [sic] computer which has a network address by authenticating fingerprints)(abstract)” (Office Action, page 4). Applicant respectfully disagrees. *Hoshino* appears to disclose a personal identification authentication system for a client terminal where a user’s fingerprint is used to authenticate the identity of a user (“The client terminal includes an authenticator, which provides an authenticating signal if the sensed fingerprint information of the client terminal user matches stored fingerprint information of the card owner.”) (*Hoshino*, abstract). Thus, *Hoshino* does not disclose or even suggest, nor has the Examiner explicitly identified any such disclosure in the *Hoshino* reference, that a “network address [is] derived from a user’s fingerprint” as recited by Claim 1 (emphasis added). Thus, for at least this reason, Applicant respectfully submits that Claim 1 is patentable over the *Hoshino* reference.

Moreover, the Examiner appears to assert that because the computer client terminal of *Hoshino* purportedly has a network address, any use of a user’s fingerprint at the client terminal necessarily equates to deriving a network address from such fingerprint (“the accessibility to [sic] computer which has a network address by authenticating fingerprints” (Office Action, page 4 (emphasis added))). Applicant respectfully disagrees. As discussed above, *Hoshino* appears to disclose that a user’s fingerprint is used to authenticate the identity of a user (*Hoshino*, abstract). The fact that the client terminal in *Hoshino* may have a network address seems irrelevant at least because a fingerprint of a user using the client terminal appears to have no bearing on such network address. Additionally, even assuming that the client terminal in *Hoshino* does have a network address, such network address clearly has no relation to a user’s fingerprint, especially because such client terminal is presumably used by a variety of

different users. Therefore, for at least these reasons also, Claim 1 is clearly patentable over the *Hoshino* reference.

Independent 6 recites “a network address derived from a fingerprint of a user,” and independent Claim 14 recites “generating a network address derived from a user’s fingerprint.” At least for the reasons discussed above in connection with independent Claim 1, Applicant respectfully submits that independent Claims 6 and 14 are also patentable over the *Hoshino* reference.

Accordingly, for at least the reasons discussed above, independent Claims 1, 6 and 14, and Claims 3 and 10 that depend respectively therefrom, are in condition for allowance.

3. Claims 3-10

Claims 3 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Ranalli*. Claims 3 and 10 depend respectively from independent Claims 1 and 6. As discussed above, Claims 1 and 6 are allowable over the cited references. Therefore, for at least this reason, Claims 3 and 10 that depend respectively therefrom are also allowable.

Further, in the Office Action, the Examiner states “*Ranalli* teaches a scanner (column 11, lines 38-43) but does not explicitly teaches [sic] a fingerprint scanner though it does use input fingerprints” (Office Action, page 5). Applicant respectfully disagrees. As discussed above in connection with independent Claim 1 (First Ground of Rejection), *Ranalli* clearly does not disclose or even suggest use of a user’s fingerprint, nor has the Examiner explicitly identified any such disclosure in the *Ranalli* reference. To the contrary, the Examiner’s arbitrary assertion that the “unique identifier” of the *Ranalli* reference “can be a fingerprint” does not rise to a level to support a rejection under § 102 or § 103. Moreover as discussed above in connection with independent Claim 1 (First Ground of Rejection), *Ranalli* recites that “the unique identifier is one readily available to those desiring to communicate with the user” (*Ranalli*, column 2, lines 22-33). Applicant

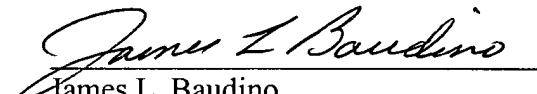
respectfully submits that a user's fingerprint is not "readily available to those desiring to communicate with the user" as indicated by *Ranalli*. Therefore, the Examiner's assertion that the "unique identifier" in *Ranalli* could be a fingerprint is clearly unsupported. Accordingly, for at least this reason also, Claims 3 and 10 are patentable over the *Ranalli* reference. Further, because the *Ranalli* does not in fact disclose any use whatsoever of a user's fingerprint, Applicant respectfully objects to any official notice asserted by the Examiner in the Office Action with respect to a fingerprint scanner ("The Examiner takes Office [sic] Notice that it would have been obvious for one skilled in the art to obtain [sic] fingerprint using a fingerprint scanner" (Office Action, page 5)).

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is authorized to charge the statutory fee of \$500.00 to Deposit Account No. 08-2025 of Hewlett-Packard Company. Although no other fee is believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,


James L. Baudino
Registration No. 43,486

Date: March 13, 2006

Correspondence To:

L. Joy Griebenow
Hewlett-Packard Company
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400
Tel. (970) 898-3884

CLAIMS APPENDIX

1. A device comprising:
connection to a network; and
network address derived from a user's fingerprint.
2. The device, as set forth in claim 1, wherein the network is the Internet and network address is an Internet address.
3. The device, as set forth in claim 1, further comprising a fingerprint scanner.
4. The device, as set forth in claim 1, further comprising a fingerprint file storing the fingerprint.
5. The device, as set forth in claim 1, further comprising a fingerprint file storing the network address derived from the fingerprint.
6. A system comprising:
a connection to a network; and
a network address derived from a fingerprint of a user.
7. The system, as set forth in claim 6, wherein the network address is derived from a fingerprint of an authorized user.
8. The system, as set forth in claim 6, wherein the network address is an Internet address.
9. The system, as set forth in claim 6, wherein the network address is an address of a global network.
10. The system, as set forth in claim 6, further comprising a fingerprint scanner.

11. The system, as set forth in claim 6, further comprising a memory storing a fingerprint file having the fingerprint.

12. The system, as set forth in claim 6, further comprising a fingerprint file storing the network address derived from the fingerprint.

13. The system, as set forth in claim 6, further comprising:
a server coupled to the Internet; and
at least one appliance coupled to the server.

14. A method, comprising:
generating a network address derived from a user's fingerprint; and
accessing a system over a network using the derived network address.

15. The method, as set forth in claim 14, further comprising obtaining a fingerprint.

16. The method, as set forth in claim 14, further comprising storing the fingerprint.

17. The method, as set forth in claim 14, further comprising generating an Internet address of the system derived from the fingerprint.

18. The method, as set forth in claim 14, wherein accessing the system comprises accessing a server coupled to the Internet using the generated network address, and accessing a plurality of appliances coupled to the server using network addresses based on the generated network address.

19. The method, as set forth in claim 14, further comprising generating system authorization based on the fingerprint.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None